

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Jeffrey A. Hubbell, Chandrashekhar P. Pathak, Amarpreet S. Sawhney, Neil P. Desai, Jennifer L. Hill, and Syed F. Hossainy

Serial No: 10/607,247 Art Unit: 1651

Filed: June 25, 2003 Examiner: David M. Naff

For: *GELS FOR ENCAPSULATION OF BIOLOGICAL MATERIALS*

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE  
PATENTING REJECTION OVER FIVE ISSUED PATENTS**

Sir:

Petitioner, Board of Regents, The University of Texas System, is the owner of the entire interest in the above-identified application and U.S. Patent No. 5,843,743, issued December 1, 1998, U.S. Patent No. 5,529,914, issued June 25, 1996, U.S. Patent No. 5,834,274, issued November 10, 1998, U.S. Patent No. 5,573,934, issued November 12, 1996, and U.S. Patent No. 6,632,446, issued October 14, 2003, as evidenced by the accompanying Statements Under 37 C.F.R. § 3.73(b). Petitioner hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 and 173 as shortened by any terminal disclaimer filed prior to the grant of U.S. Patent No. 5,843,743, U.S. Patent No. 5,529,914, U.S. Patent No. 5,834,274, U.S. Patent No. 5,573,934, and U.S. Patent No. 6,632,446, or any continuation thereof under 37 C.F.R. § 1.53(b). Petitioner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such

period that it and U. S. Patent No. 5,843,743, U.S. Patent No. 5,529,914, U.S. Patent No. 5,834,274, U.S. Patent No. 5,573,934, and U.S. Patent No. 6,632,446, are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, petitioner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173 of U. S. Patent No. 5,843,743, U.S. Patent No. 5,529,914, U.S. Patent No. 5,834,274, U.S. Patent No. 5,573,934, and U.S. Patent No. 6,632,446, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that the granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.


The undersigned (whose title is supplied below) is empowered to act on behalf of Board of Regents, The University of Texas System.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States

U.S.S.N. 10/607,247  
Filed: June 25, 2003  
TERMINAL DISCLAIMER TO OBVIATE A  
DOUBLE PATENTING REJECTION  
OVER FIVE ISSUED PATENTS

Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

**BOARD OF REGENTS, THE UNIVERSITY  
OF TEXAS SYSTEM**

By:  \_\_\_\_\_

Name: Barry D. Burgdorf

Title: Vice Chancellor and General Counsel

Date: March 2, 2006

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**STATEMENT UNDER 37 CFR 3.73(b)**

Applicant/Patent Owner: Jeffrey A. Hubbell, Chandrashekhar P. Pathak, Amarpreet S. Sawhney, Neil P. Desai, Jennifer L. Hill, and Syed F. Hossainy

Application No./Patent No./Control No.: 10/607,247 Filed/Issue Date: June 23, 2003

Entitled: GELS FOR ENCAPSULATION OF BIOLOGICAL MATERIALS

Board of Regents, The University of Texas System, a university

(Name of Assignee)

(Type of Assignee: corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of less than the entire right, title and interest  
(The extent (by percentage) of its ownership interest is \_\_\_\_\_ %)

in the patent application/patent identified above by virtue of either:

A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 017250, Frame 0139, or a true copy of the original assignment is attached.

OR

B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.
2. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.
3. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Barry D. Burgdorf Signature

March 2, 2006

Barry D. Burgdorf

Date

Printed or Typed Name

512/499-4462

Vice Chancellor and General Counsel

Telephone Number

Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**STATEMENT UNDER 37 CFR 3.73(b)**Jeffrey A. Hubbell, Chandrasekhar P. Pallak, Amarpreet S. Sawhney, Neil P. Desai,  
Jennifer L. Hill and Syed F. A. HossainyApplicant/Patent Owner: \_\_\_\_\_  
Application No./Patent No.: 5,843,743 Filed/Issue Date: December 1, 1998Entitled: GELS FOR ENCAPSULATION OF BIOLOGICAL MATERIALS

Board of Regents, The University of Texas System, a university

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

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2. ☐ an assignee of less than the entire right, title and interest.  
The extent (by percentage) of its ownership interest is \_\_\_\_\_ %

In the patent application/patent identified above by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 8577, Frame 0041, or for which a copy thereof is attached. Recorded under U.S.S.N. 08/024,657, filed March 1, 1993.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

2. From: \_\_\_\_\_ To: \_\_\_\_\_  
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3. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

- ☐ Copies of assignments or other documents in the chain of title are attached.  
[NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

March 13, 2002  
Date

Cullen M. Godfrey

Typed or printed name

  
Signature

Vice Chancellor and General Counsel

Title

Standard Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

USPS 403 CIP (2) DIV (1) 077831/00014

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**STATEMENT UNDER 37 CFR 1.73(b)**Applicant/Patent Owner: Jeffrey A. Hubbell, Chandrasekhar P. Pathak, Anandpreet S. Sawhney, Neil P. Desai,  
and Syed F. A. HassainyApplication No./Patent No.: 5,529,914 Filed/Issue Date: June 25, 1996Entitled: GELS FOR ENCAPSULATION OF BIOLOGICAL MATERIALSBoard of Regents, The University of Texas System, a university

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

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2. ☐ an assignee of less than the entire right, title and interest.  
The extent (by, percentage) of its ownership interest is \_\_\_\_\_ %

In the patent application/patent identified above by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 6536, Frame 0245, or for which a copy thereof is attached.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.
2. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.
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The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

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The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

March 13, 2002

Date

Cullen M. Godfrey

Typed printed name

Signature

Vice Chancellor and General Counsel

Title

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LTSB 493 CIP (1) 077637100019

**STATEMENT UNDER 37 CFR 3.73(b)**

Jeffrey A. Hubbell, Chandrasekhar P. Pathak, Amarpreet S. Sawhney, Neil P. Desai,  
Jennifer L. Hill and Syed F. A. Hossainy

Applicant/Patent Owner: \_\_\_\_\_  
Application No./Patent No.: 5,834,274 Filed/Issue Date: November 10, 1998

Entitled: GELS FOR ENCAPSULATION OF BIOLOGICAL MATERIALS

Board of Regents, The University of Texas System, a university  
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

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In the patent application/patent identified above by virtue of either:

A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 5577, Frame 0041, or for which a copy thereof is attached. Recorded under U.S.S.N. 80/024,657, filed March 1, 1993.

OR

B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

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Cullen M. Godfrey  
Type or printed name  
Cullen M. Godfrey  
Signature

Vice Chancellor and General Counsel  
Title

**STATEMENT UNDER 37 CFR 3.73(b)**

Jeffrey A. Hubbell, Chandrasekhar P. Pothak, Amarpreet S. Sawhney, Nall P. Desai,  
Applicant/Patent Owner: Jennifer L. Hill West and Syed F. A. Hossainy  
Application No./Patent No.: 5,573,934 Filed/Issue Date: November 12, 1996  
Entitled: GELS FOR ENCAPSULATION OF BIOLOGICAL MATERIALS  
Board of Regents, The University of Texas System, a university  
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

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Jeffrey A. Hubbell, Chandrasekhar P. Pathak, Amarpreet S. Sawhney,  
Applicant/Patent Owner: Neil P. Desai, Jennifer L. Hill and Syed F.A. Hossainy

Application No./Patent No.: 09/694,836 /6,632,446 Filed/Issue Date: October 23, 2000 /October 14, 2003

Entitled: Gels for Encapsulation of Biological Materials

Board of Regents, The University of Texas System, a university

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

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2. ☐ an assignee of less than the entire right, title and interest.  
The extent (by, percentage) of its ownership interest is \_\_\_\_\_ %

In the patent application/patent identified above by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application identified above, which is a continuation of U.S.S.N. 09/033,971 which is a continuation of 08/467,693 which is a divisional of U.S.S.N. 08/024,667 which is a CIP of U.S.S.N. 07/958,870 which is a CIP of U.S.S.N. 07/870,540.

OR

The Assignment was recorded in the United States Patent and Trademark Office at Reel 8577, Frame 0041.

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

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NOV 13 2002

Date

Cullen M. Godfrey

Typed or printed name

*Cullen M. Godfrey*

Signature

Vice Chancellor & General Counsel  
Title